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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/500,162	02/08/2000	Judes Poirier	08523/006002	2201

7590

03/13/2002

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EXAMINER

PARKIN, JEFFREY S

ART UNIT

PAPER NUMBER

1648

DATE MAILED: 03/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/500,162

Applicant(s)  
Poirier, J.

Examiner  
Jeffrey S. Parkin, Ph.D.

Art Unit  
1648



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 Dec 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) 17-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 20) ☐ Other:

**Detailed Office Action**

***Status of the Claims***

1. Applicant's election of Group I (claims 1-16) in paper no. 4 is acknowledged. Because applicant did not distinctly and specifically point out the purported errors in the restriction requirement, the election has been treated as an election without traverse (refer to M.P.E.P. § 818.03(a)). Claims 17-20 are withdrawn from further consideration by the examiner, pursuant to 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

***Information Disclosure Statement***

2. The information disclosure statement filed 08 February, 2000, has been placed in the application file and the information referred to therein has been considered.

***35 U.S.C. § 112, Second Paragraph***

3. Claims 1-16 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are incomplete and fail to clearly set forth all the salient features of the claimed methodology. For instance, claim 1 contains a step wherein the apoE allele load of a patient is ascertained and this leads to a prognosis protocol and prediction of drug efficacy. However, the claim fails to set forth any correlation between the apoE allele load and drug efficacy predictions. Does an increase in a specific apoE allele (e.g., 1, 2, 3, 4) correlate with increased responsiveness to certain types of drugs? Conversely, is it predictive of the patient being refractory to certain types of treatments? Applicants should amend the claim language to include all those salient steps required to practice the invention.

**35 U.S.C. § 112, First Paragraph**

4. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

5       The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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5. Claims 1-14 are rejected under 35 U.S.C. § 112, first paragraph, because the specification does not reasonably enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. The claimed invention is broadly directed  
15 toward the use of apoE allele determinations to predict the clinical efficacy of a given drug in patients with various neuropathologies.

20       The legal considerations that govern enablement determinations pertaining to undue experimentation are disclosed in *In re Wands*, 8 U.S.P.Q.2d 1400 (C.A.F.C. 1988) and *Ex parte Forman* 230 U.S.P.Q. 546 (PTO Bd. Pat. App. Int., 1986). The courts concluded that several factual inquiries should be considered when making such assessments including the quantity of experimentation necessary, the amount of direction or guidance presented, the presence or absence of working  
25 examples, the nature of the invention, the state of the prior art, the relative skill of those in that art, the predictability or unpredictability of the art and the breadth of the claims. *In re Rainer*, 52 C.C.P.A. 1593, 347 F.2d 574, 146 U.S.P.Q. 218 (1965). The disclosure fails to provide adequate guidance pertaining to a number  
30 of these considerations as follows.

      The disclosure fails to provide adequate guidance and support pertaining to the relationship between the apoE allele load and the various neuropathologies claimed by applicant (e.g., Creutzfeldt-Jakob disease, congenital defects in amino acid metabolism, fragile

X syndrome, and Huntington's disease). The underlying disease mechanisms in many of these disorders remain to be elucidated (Timchenko et al., 1996; Salvatore et al., 1995; and Brouillet et al., 1995). As Timchenko et al. (1996) conclude (refer to Abstract, page 1589), "Diagnostic procedures for these disorders are only beginning to be standardized, and effective therapy will have to wait for further information on disease mechanisms." Moreover, Salvatore et al. (1995) report (refer to Abstract, page 95) that "Our results provide further evidence that ApoE is not a risk factor for CJD." Moreover, the disclosure fails to provide any working embodiments directed toward these aspects of the invention. Accordingly, in view of the unpredictability of the prior art, the skilled artisan has only been extended an undue invitation to additional experimentation.

#### **Correspondence**

6. Correspondence related to this application may be submitted to Group 1600 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Official communications should be directed toward one of the following Group 1600 fax numbers: (703) 308-4242 or (703) 305-3014. Informal communications may be submitted directly to the Examiner through the following fax number: (703) 308-4426. Applicants are encouraged to notify the Examiner prior to the submission of such documents to facilitate their expeditious processing and entry.

7. Any inquiry concerning this communication should be directed to Jeffrey S. Parkin, Ph.D., whose telephone number is (703) 308-2227. The examiner can normally be reached Monday through Thursday from 8:30 AM to 6:00 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner are unsuccessful, the examiner's supervisors, James Housel or Laurie Scheiner, can be reached at (703) 308-4027 or (703) 308-1122, respectively. Any

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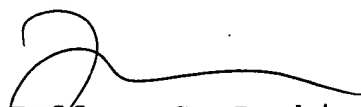
Applicant: Poirier, J.

inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703) 308-0196.

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Respectfully,

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Jeffrey S. Parkin, Ph.D.  
Patent Examiner  
Art Unit 1648

08 March, 2002